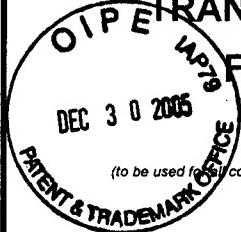


AP-1111

TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>		Attorney Docket No.	2100/23
		Application Number	09/993,359
		Filing Date	November 19, 2001
		First Named Inventor	Scott D. Slomiany
		Group Art Unit	3714
		Examiner	Corbett B. Coburn

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Amendment / Response to Restriction/Election Req.	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i>	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Drawings:	<input checked="" type="checkbox"/> Appeal Communication to Group (Reply Brief to Examiner's Answer mailed October 31, 2005)
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> After Allowance Communication to Group	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input checked="" type="checkbox"/> Post Card Receipt
<input type="checkbox"/> Extension of Time Request (duplic)	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Additional Enclosure(s) <i>(please identify below):</i>
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/>
<input type="checkbox"/> Information Disclosure Statement, PTO-1449, art	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/>
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Applicant claims small entity status.	<input type="checkbox"/>
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Request of Refund	<input type="checkbox"/>
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 50-0930. A duplicate copy of this sheet is enclosed.		

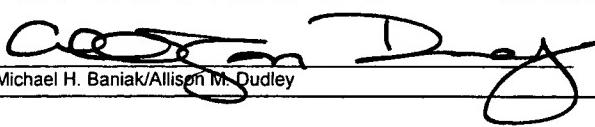
CALCULATION OF FEE

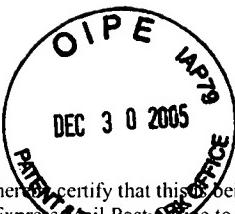
	Claims After Amendment		Highest No. Previously Paid For	Present Extra	Small Entity		Large Entity	
Total		Minus	(20)	0	Rate	Add'l Fee	or	Rate
Indep.		Minus	(3)	0	x \$25=	0		x \$50=
First Presentation of Multiple Dep. Claim					x \$100=	0		x \$200=
					+\$180=	—		+\$360=
					total add'l fee	\$ 0		total add'l fee
								\$ 0

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Michael H. Baniak, Reg. No. 30,608 Allison M. Dudley Reg. No. 50,545 Attorneys for Applicants BANIAK PINE & GANNON 150 N. Wacker Drive, Suite 1200 Chicago, Illinois 60606		
Signature			Date: December 30, 2005

CERTIFICATE OF MAILING

I hereby certify that this is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and is addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, under Express Label No. EV 498 081 130 US on:			December 30, 2005
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PATENT
2100/23

Allison M. Dudley

Signature

December 30, 2005

Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/993,359
Applicant(s) : Scott D. SLOMIANY,
: Lawrence E. DEMAR, and
: Duncan F. BROWN
Filed : November 19, 2001
TC/A.U. : 3714
Examiner : Corbett B. Coburn
Docket No. : 2100/23
Title : BUNCO GAMING DEVICE,
METHOD AND BONUS GAME

Examiner: Corbett B. Coburn

Group Art Unit: 3714

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Alexandria, VA 22313-1450

Before the Board of Patent Appeals and Inferences:

This is in reply to the Examiner's Answer mailed October 31, 2005.

REMARKS AND ARGUMENTS IN REPLY

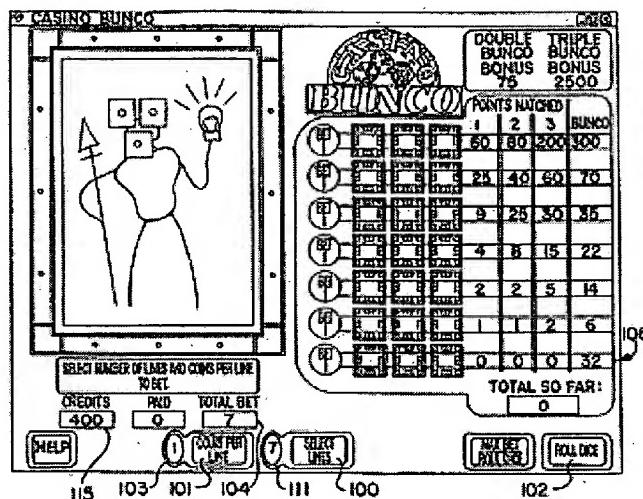
Claims 109-115 are on appeal. The Examiner's Answer maintains the rejections under 35 U.S.C. 103(a) over U.S. Patent No. 5,263,715 to Matsumoto (hereinafter "Matsumoto") in light of U.S. Patent No. 2,125,236 to Edgeworth (hereinafter "Edgeworth") and Bunco rules. For the rejection over Matsumoto in light of Edgeworth and Bunco rules, Claims 109-115 stand together. Claims 113 and 114 are rejected under 35 U.S.C. 103(a) over Matsumoto, Edgeworth, Bunco rules and further in view of U.S. Patent No. 5,647,798 to Falciglia (hereinafter "Falciglia"). For the rejection over Matsumoto in light of Edgeworth, Bunco rules and Falciglia, Claims 113 and 114 stand together.

(I) WHY MATSUMOTO, EDGEWORTH AND BUNCO RULES DO NOT RENDER CLAIMS 109-115 OBVIOUS

The Examiner argues Matsumoto is a slot machine that implements dice games, Edgeworth suggests playing Bunco on a slot machine, and Bunco is a well known game that one of ordinary skill in the art would be motivated to look at when implementing a Bunco game.

The present invention is a dice game having *attributes* of Bunco, but is not a traditional Bunco game. The present Bunco-type embodiment is an ongoing game with stages that, as a result of the nature of the game, also involve multi-stage betting, wherein multiple bets are placed on different stages of the game, working with an evolving game. The present invention is directed to a Bunco-type video gaming machine that has a set of differing dice elements.

FIG. I



In the present invention, any number on dice elements that has been rolled on every stage of the current game is a match point. (e.g., Claim 109 recites “at least one match point at the start of the game, each said match point having a match indicium for potential matching with a subsequent toss of the dice elements”). On the first stage of gameplay, each number that appears on a die becomes a point, for a possible total of three points if all three dice are different (that is, all six possible numbers on each die are points for the first stage). After the dice are tossed, a determination is made as to whether any match is made between the randomly selected match indicia from the first stage and the dice tossed on the second stage. (e.g., Claim 109 recites “displaying a random toss of a plurality of dice elements at each stage of play, and determining for each die element tossed at a stage of play whether its randomly selected indicium matches said match indicium of said match point”). On the second stage, the player must match one or more points determined from the first stage to keep the game going -- any numbers that were rolled on both the first and second stages remain points for the third stage. (e.g., Claim 112 recites “at least one match point at the start of the game, each said match point having a match indicium for potential matching with a subsequent toss of the dice elements”). Instead of being a single number, there may be up to three points that the player is trying to roll. (e.g., Claim 111 recites “three dice elements are established and displayed as being tossed at each stage of play”).

Other embodiments of the invention are directed to a randomly allocated free advancement feature along with elimination from play any match point that is not matched on a toss. (e.g., Claim 113 recites “a randomly allocated free advancement feature, and determines a game ending condition if no match is made at a stage of play unless said free advancement feature has been allocated, in which event the game continues to the next stage of play”). Play continues provided that at least one match point remains for each successive stage. In addition, the free advancement feature allows the game to continue to the next stage of play in the event the match point is not matched on a toss. (e.g., Claim 114 recites “said program further eliminating from play any match point which is not matched on a toss ... unless said free advancement feature has been allocated, in which event the game continues to the next stage of play”).

The present invention includes embodiments wherein the match indicium is randomly selected -- some or all of the match indicia may thereby be the same. (e.g., Claim 115 recites “each of said plurality of match points having a match indicium selected at random, whereby some or all of said match indicia of said plurality of match points may thereby be the same”)

In short, every successive stage is dependent upon the previous stage of gameplay. The player continues to roll until no dice match a number found in all previous stages, or until the highest stage upon which a bet has been placed. At least one match comprises a winning condition for a stage being played, but if a match is not made, then the unmatched indicium is removed from the next successive stage of play. If a match is made, the next stage is played provided the player’s wager included the next successive stage to be played. If a match is not made, the game ends and the player loses all wagers placed on successive stages of play (unless a free advancement feature is provided).

(A.) Matsumoto Does Not Teach a Number of Successive Stages According to the Present Invention

The Examiner argues Matsumoto is a slot machine that implements dice games. The Examiner also argues Matsumoto teaches playing a dice game with match points and a number of successive states by relying on Matsumoto’s disclosure of Craps. As the Examiner accurately notes, however, Matsumoto does not teach Bunco or matching the indicium of each die element tossed with the randomly selected match indicium of the match point.

The object of Matsumoto is to provide a dice displaying apparatus to give a “pseudo-real” feeling of throwing dice. Matsumoto was designed to solve the problem of a lack of a sense of reality when playing computing gaming machines for displaying images of dice. Matsumoto describes and claims a dice displaying apparatus that includes a trackball to roll the dice.

Although Matsumoto teaches accepting bets and paying winnings, the Examiner is respectfully wrong about Matsumoto teaching successive stages to be played according to the present invention. As the Examiner notes, a player of Craps shoots to determine if he wins, loses or has a match point. If a point matches, the player rolls again, but this roll has no interdependency on the previous roll in which the player matched a point. There is no game related dependency on the previous roll. Craps is an entirely different game than the successive stage Bunco-type game according to the present invention in which each successive stage of play builds upon one another. (e.g., Claim 112 recites “at least one match point at the start of the game, each said match point having a match indicium for potential matching with a subsequent toss of the dice elements”).

In the present invention, any number that has been rolled on every stage of the current game is a match point. Instead of being a single number, there may be up to three points that the player is trying to roll. After the dice are tossed, a determination is made as to whether any match is made between the randomly selected match indicia from the previous stage and the dice tossed on the current stage. Any numbers that were rolled on previous stages remain points for any successive stage. Thus, every successive stage is dependent upon the previous stage of gameplay. The player continues to roll until no dice match a number found in all previous stages, or until the highest stage upon which a bet has been placed. At least one match comprises a winning condition for a stage being played, but if a match is not made, then the unmatched indicium is removed from the next successive stage of play. If a match is made, the next stage is played provided the player’s wager included the next successive stage to be played. If a match is not made, the game ends and the player loses all wagers placed on successive stages of play.

Craps is not a game of successive stages according to the present invention. In Craps, an unmatched indicium is not removed from successive stages of play. Furthermore, any number that has been rolled does not remain as a match point for successive stages of play. Additionally,

Craps does not require a wager on successive stages in order for the player to play that stage. Matsumoto fails to teach or suggest a game with successive stages to be played along with implementing a Bunco-type dice game on a slot machine according to the present invention.

(B.) Edgeworth Does Not Teach a Video Display Device Including a Wager and Payout According to the Present Invention.

Edgeworth does not satisfy the deficiencies of Matsumoto. Here again, the Examiner is, respectfully, incorrect on two grounds. First, Edgeworth is not a slot machine and second, although the specification of Edgeworth mentions in passing that the invention may be adaptable to dice games such as “twenty six” and “Bunco”, the present invention is *not Bunco*.

A slot machine includes a wager and a payout.¹ Edgeworth is not a slot machine, but an arcade game, that requires insertion of a coin to begin play. In Edgeworth, the token or coin works in conjunction with the control means to manage operation of the apparatus unit to oscillate the operator arm thirteen times. Upon completion of the game, the coin is released into a container. There is no payout upon a conclusion of gameplay. Edgeworth is not a wagering game or a game that distributes a payout.

Edgeworth discloses an apparatus including a turn-table, trap, feeler pins and dial device for manipulation of dice elements during play of a game. Ten dice are confined to an enclosure with a top circular opening arranged to rotate a turn-table or disc. After the dice have been tumbled, with a maximum of thirteen rolls, they are directed into a trap with feeler pins that registers the number of dice displaying a certain character. Although the specification of Edgeworth mentions the game of “Bunco”, the present invention is quite different than the game of Bunco.

Bunco is played in “rounds”. The first round starts with all tables rolling for a “point” of one. The second round starts with all tables rolling for a “point” of two. The “point” increases by one for each subsequent round. Unlike Bunco described above, the present invention randomly selects a match point. Instead of being a single number, there may be up to three

¹ According to the United States Internal Revenue Service, a slot machine operates by means of the insertion of a coin, token, or similar object and which, by application of the element of chance, may deliver, or entitle a person playing or operating the machine to receive, cash, premiums, merchandise, or tokens. Internal Revenue Code § 4462(a); see <http://www.taxlinks.com/rulings/1962/revrul62-135.htm>

points that the player is trying to roll. Any numbers that were rolled remain points for successive stages of gameplay. Thus, every successive stage is dependent upon the previous stage of gameplay. If a match is not made, then the unmatched indicium is removed from the next successive stage of play. If a match is made, the next stage is played provided the player's wager included the next successive stage to be played.

Edgeworth does not teach a video display device including a wager and payout (according to a paytable) as claimed in the present invention. Nowhere does Edgeworth disclose a Bunco-type dice game with successive stages played according to the present invention. Furthermore, Edgeworth does not establish a subset of at least one match point.

(C.) There is No Motivation to Combine the Teachings of Matsumoto and Edgeworth

The Examiner argues Edgeworth in combination with Matsumoto suggests implementing Bunco on a slot machine.² Although Matsumoto discloses a slot machine that implements dice games and Edgeworth discloses playing Bunco on an apparatus including a turn-table, trap, feeler pins and dial device for manipulation of dice elements during play of a game, there is no motivation to combine these references.

As the Examiner acknowledges, Edgeworth is old technology including purely mechanical gears and wheels that the gaming machine industry has long abandoned to adopt processors and video screens of Matsumoto. The Examiner's own statement of abandoning old technology for new technology proves there is no suggestion or motivation to combine these references.

At best, the combination of Matsumoto and Edgeworth teach a computerized slot machine with mechanical gears and wheels to toss dice. Edgeworth, an apparatus of mechanical gears and wheels to tumble and manipulate dice elements during play of a game, teaches away from the computerized slot machine of Matsumoto. Accordingly, Matsumoto and Edgeworth cannot render the present claims obvious.

² Page 9 of the Examiner's Answer states an incomplete sentence regarding a combination. The Appellant is unsure what combination to which the Examiner is referring.

(D.) The Present Invention Is Not Then Rendered Obvious In Light Of Traditional Bunco Rules

The traditional rules of Bunco do not fulfill the deficiencies of Matsumoto and Edgeworth in light of the lack of motivation to combine these references as described above. As further described above, the present invention is not a traditional Bunco game. Although the present invention has attributes of a Bunco game, it is not obvious in light of the traditional rules of Bunco. It is very different from the rules of Bunco. This significant difference is something the Examiner has continuously failed to appreciate. The present invention is distinctly different than traditional Bunco.

As described in detail above, there are many differences between the present invention and Bunco, some the Examiner noted, others the Examiner failed to recognize.

The Examiner is respectfully traversed, in that the differences between the Appellants' invention and Bunco *are* claimed. For example, independent claim 109 claims "a program establishing a set of differing gameplay dice elements, including a subset of at least one match point at the start of the game, each said match point having a match indicium for potential matching with a subsequent toss of the dice elements." Furthermore, claim 115 claims "a plurality of match points are established, each of said plurality of match points having a match indicium selected at random." The rules of Bunco do not disclose these aspects of the claimed invention. Bunco does not have a match point with a match indicium for potential matching on subsequent stages of play.

(E.) There is No Motivation to Combine the Teachings of Matsumoto, Edgeworth and Bunco Rules

As described above, one skilled in the art would not be motivated to combine the old technology of Edgeworth with the new technology of Matsumoto.

The Examiner is misplaced that Edgeworth teaches implementing a Bunco-type game on a slot machine with wagering. Edgeworth discloses Bunco, not a Bunco-type game and additionally does not disclose a slot machine with a wager and payout. Edgeworth fails to teach the details of the Bunco-type game of the present invention. Although one skilled in the art may know the rules of Bunco, the rules of Bunco do not teach or suggest the Bunco-type game of the

present invention. Thus, the Bunco-type game of the present invention is not obvious in light of the traditional rules of Bunco.

There is no motivation or suggestion to combine Matsumoto, Edgeworth and Bunco rules to arrive at the Appellant's claimed invention.

(II.) MATSUMOTO, EDGEWORTH, BUNCO RULES AND FALCIGLIA DO NOT RENDER CLAIMS 113 AND 114 OBVIOUS

Matsumoto, Edgeworth and Bunco Rules are described and distinguished above. Falciglia is an apparatus including a plurality of spinning wheels for playing Bingo on a slot machine. Although Falciglia discloses an extra spin on the Bingo slot machine to try to obtain a winning Bingo combination if a spinning wheel stops on a free spin position, there is no suggestion or motivation to combine this reference with the dice games of Matsumoto, Edgeworth and Bunco Rules. The Bingo game of Falciglia teaches away from the dice games disclosed in Matsumoto, Edgeworth and Bunco Rules.

Claims 113 and 114 contain all the limitations of independent Claim 109. Since Claim 109 is allowable over the references cited for the reasons stated above, Claims 113 and 114 are also allowable since they depend from an allowable independent Claim. Matsumoto, Edgeworth Bunco rules and Falciglia, alone or in combination, do not disclose each and every element of Claim 109, and a randomly allocated free advancement feature of Claims 113-114 dependent thereon.

(III.) THE EXAMINER'S HINDSIGHT REASONING INCLUDES KNOWLEDGE GLEANED FROM THE APPELLANT'S DISCLOSURE

The Examiner perhaps believes that he has not used hindsight knowledge gleaned from the Appellants' disclosure, but he has plainly done so. *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed Cir. 2000) ("The Examiner and the Board fell into the hindsight trap."); *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (The Board fell into the hindsight trap by "combining prior art references without evidence of such a suggestion, teaching, or motivation and simply took the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.")

Not one of the prior art references teaches the play of the inventive Bunco-type game that includes any number rolled on each stage is a match point, the match point may be randomly selected, each successive stage of play is dependent upon the previous stage of play in that if a match is not made after roll of the dice, then the unmatched indicium is removed from the next successive stage of play. Furthermore, if a match is made, the next stage is played only if the player's wager included the next successive stage to be played.

Matsumoto fails to teach or suggest a game with successive stages to be played along with implementing a Bunco-type dice game on a slot machine according to the present invention. Although Matsumoto explicitly discloses Craps, Craps is not a game of successive stages wherein an unmatched indicium is removed from successive stages of play. Furthermore, any number that has been rolled does not remain as a match point for successive stages of play and Craps does not require a wager on successive stages in order for the player to play that stage.

As described above, Edgeworth teaches away from being combined with Matsumoto. Nowhere does Edgeworth or Bunco rules disclose a dice game with any number rolled on each stage is a match point, the match point may be randomly selected, each successive stage of play is dependent upon the previous stage of play in that if a match is not made after roll of the dice, then the unmatched indicium is removed from the next successive stage of play. Furthermore, if a match is made, the next stage is played only if the player's wager included the next successive stage to be played. Additionally, neither Edgeworth nor Bunco rules requires a wager or a payout.

The Examiner has hunted and pecked through the prior art to find very disparate references from which he takes only pieces of them which are then attempted to be put together to meet Claim 109; yet even so, those pieces do not add up to Claim 109. The combined teachings of the references cited would not teach or suggest to one of ordinary skill in the art the claimed invention of a video display device including a wager and a program to match the randomly selected match point to the randomly selected indicia of the dice element, which also determines the payout, along with successive stages of play as claimed in the present invention.

The Examiner contents one of ordinary skill in the art would have been motivated to implement Bunco on a slot machine to attract players who enjoy Bunco, yet no one but

Appellants have adapted it to a video gaming machine in all that time, and a specialized game at that. The prior art relied upon by the Examiner shows that Appellants are indeed the first to make a video gaming machine based upon a Bunco-type dice game. This alone shows unobviousness, since as the Examiner recounts, "Bunco is a tremendously popular game".

(IV.) STRUCTURES THAT ARE NOT FOUND IN THE PRIOR ART

The Examiner contends the Appellant is required to explain why each claim is separately patentable. Allowance of independent claim 109 would, of course, be enough, given that the rest depend therefrom.

Nonetheless, dependent Claims 110-111 both require a bonus award that increases with each successive stage of play and including the step of awarding a bonus award if all dice elements on a toss have the same randomly selected indicium which also matches a match indicium. There is no showing this is present in the cited art. Matsumoto, Edgeworth and Bunco rules, alone or in combination, do not disclose each and every element of Claim 109, and a bonus award that increases with each successive stage of play Claims 110-111 dependent thereon.

Claim 112 further requires elimination from play any match point which is not matched on a toss, and determines whether to continue with a toss on a subsequent stage of play up to a preset maximum number of stages provided that at least one match point remains for each such subsequent stage. There is no showing this is present in the cited art. Matsumoto, Edgeworth and Bunco rules, alone or in combination, do not disclose each and every element of Claim 109, and elimination from play any match point which is not matched on a toss of Claim 112 dependent thereon.

Claim 113 further requires a randomly allocated free advancement feature. There is no showing this is present in the cited art. Matsumoto, Edgeworth and Bunco rules, alone or in combination, do not disclose each and every element of Claim 109, and a randomly allocated free advancement feature of Claim 113 dependent thereon.

Claim 114 further requires a randomly allocated free advancement feature, which any match point that is not matched on a toss is eliminated from play, and determines whether to continue with a toss on a subsequent stage of play up to a preset maximum number of stages provided that at least one match point remains for each such subsequent stage unless the free

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Reply to Examiner's Answer Mailed October 31, 2005

advancement feature has been allocated, in which event the game continues to the next stage of play. There is no showing this is present in the cited art. Matsumoto, Edgeworth and Bunco rules, alone or in combination, do not disclose each and every element of Claim 109, and a randomly allocated free advancement feature of Claim 114 dependent thereon.

Claim 115 further requires a plurality of match points where each of the plurality of match points have a match indicium selected at random, whereby some or all of the match indicia of the plurality of match points may thereby be the same. There is no showing this is present in the cited art. Matsumoto, Edgeworth and Bunco rules, alone or in combination, do not disclose each and every element of Claim 109, and a randomly selected match indicium of Claim 115 dependent thereon.

In the absence of these elements, Matsumoto, Edgeworth and Bunco rules cannot render Claims 109-115 obvious.

(V) CONCLUSION

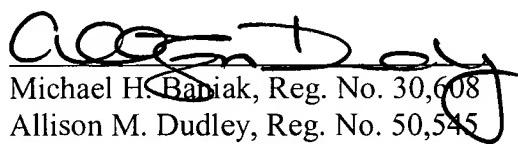
It should be now apparent that the Examiner's amalgamation of Matsumoto, Edgeworth, Bunco rules and Falciglia is incorrect. Neither Matsumoto nor Edgeworth nor Bunco rules nor Falciglia, alone or in combination, teach, suggest or provide the motivation to be combined in any arrangement to arrive at the Appellants' invention. Numerous elements in the Appellants' claims cannot be found in any reference.

For at least the foregoing reasons, Appellants respectfully request that the Board allow the claims under appeal.

Respectfully submitted,

December 30, 2005

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